

PES-0043

REMARKS

Claims 1-2, 5-11, 15-25, 40-44, 51-53, and 56-57 are pending in the present Application. Claims 1, 11, 40-44, 50, and 52-53 have been canceled, Claims 2, 18, 20, 21, 22, 25, and 51 have been amended, leaving Claims 2, 5-10, 15-25, 51, and 56-57 for consideration upon entry of the present Amendment.

Claims 2, 18, and 20 have been amended such that the claims do not depend upon a canceled base claim. More particularly, each of these claims has been amended to depend from independent Claim 21, which Applicants believe is allowable.

Claims 21, 22, 25, and 51 have been rewritten as independent claims.

Applicants respectfully request that these amendments be entered because they 1) do not raise new issues that would require further consideration and/or search because; 2) they do not raise issue of new matter because; 3) no new claims have been added; and 4) the amendments place the claims in a better condition for allowance.

Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 2, 5-7, 9, 10, 18-20, and 50 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,030,718 to Fuglevand et al.

For the purposes of this response, Applicants assumed that the Examiner's intention was to reject the claims under 35 U.S.C. § 102(a), since the publication date of Fuglevand et al. is less than one year prior to the effective filing date of this Application. However, this point and rejection are moot, since independent Claims 1 and 50 have been canceled without prejudice. The dependency of the remaining claims have been amended to directly or indirectly dependent from Claim 21 (rewritten as an independent claim), which Applicants believe is allowable for the reasons set forth below.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 11 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,030,718 to Fuglevand et al.

PES-0043

This rejection is moot, as Claim 11 has been canceled without prejudice.

Claim 56 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over WO 97/13287 to Mussell et al. in view of U.S. Published Patent Application No. 2001/0008722 to Speranza et al. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the present Application claims priority to U.S. Provisional Patent Application Serial No. 60/235,743 filed on September 27, 2000; U.S. Provisional Patent Application Serial No. 60/235,821 filed on September 27, 2000; and, U.S. Provisional Patent Application Serial No. 60/235,974 filed on September 28, 2000.

In making the rejection the Examiner relied upon Speranza et al. for disclosing screens made of niobium, zirconium, tantalum, titanium, and cobalt. However, Applicants disclose these elements in their provisional applications. As such, Applicants' priority date antedates the effective date of March 8, 2001 for Speranza et al. Therefore, Speranza et al. is not prior art under 35 U.S.C. § 102(a). Moreover, since Mussell et al. by themselves fail to teach or suggest these materials, Mussell et al. fail to teach or suggest at least one element of Applicants' claimed invention. Accordingly, independent Claim 56 is not obvious and is therefore allowable.

Claims 40 and 41 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,641,586 to Wilson. Claim 53 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,641,586 to Wilson in view of U.S. Published Patent Application No. 2001/0036523 to Sobolewski.

These rejections are moot, as Claims 40, 41, and 53 have been canceled without prejudice.

Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,030,718 to Fuglevand et al. in view of U.S. Patent 5,641,586 to Wilson. Applicants respectfully traverse this rejection.

As correctly noted by the Examiner, Fuglevand et al. fail to teach or suggest a screen support made of nickel or steel. (Final O.A., page 6).

PES-0043

However, in making the rejection the Examiner stated that "an artisan would be motivated to use nickel or steel in the member of Wilson '586. As would be appreciated by the artisan, these materials have characteristics such as high strength and high oxidation resistance." (Final O.A., page 6). Since neither nickel nor steel are mentioned in Wilson and Fuglevand et al., Applicants requested in their last response that the Examiner supply a secondary reference indicating that these materials are taught or suggested in the manner as claimed by Applicants.

In response to Applicants' request, the Examiner cited U.S. Published Patent Application No. 2001/0008722 to Speranza et al., which has an effective date after Applicants' priority date as discussed above. In other words, Speranza et al. is not available as prior art. As such, the Examiner still has failed to establish a *prima facie* case of obviousness, for at least the reason that a screen support made of nickel or steel is not taught or suggested by Fuglevand et al. in view of Wilson. Accordingly, independent Claims 8 and 21 are not obvious and are therefore allowable over Fuglevand et al. in view of Wilson.

Claim 52 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,030,718 to Fuglevand et al. in view of U.S. Published Patent Application No. 2001/0036523 to Sobolewski.

This rejection is moot, as Claim 52 has been canceled without prejudice.

Claims 40-44 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over WO 97/13287 to Mussell et al. in view of U.S. Patent 5,641,586 to Wilson.

This rejection is moot, as Claims 40-44 have been canceled without prejudice.

Claims 15, 22-25, and 51 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,030,718 to Fuglevand et al. in view of WO 97/13287 to Mussell et al. Applicants respectfully traverse this rejection.

Independent Claim 15 comprises, *inter alia*, the following elements: the flow field member comprises a porous support having a selected hydrophobicity, a selected hydrophilicity, a combination of a selected hydrophobicity and selected porosity, or a combination of a selected hydrophilicity and selected porosity, wherein the porous flow field member comprises a first

PES-0043

layer comprising a first layer having a first hydrophobicity, and a second layer having a second, different hydrophobicity, wherein the first layer has a first porosity and the second layer has a second, different porosity.

Applicants respectfully submit that the claimed combination of hydrophobicity and porosity is not taught or suggested by the combined references. As correctly noted by the Examiner Fuglevand et al. does not teach different porosities. Rather, the Examiner relied upon Mussell et al. for teaching two layers having different porosity. However, absent in the references themselves is the necessary teaching or suggestion that would have lead one of skill in the art to modify these references with any reasonable expectation of success at making Applicants' claimed invention. At best, each reference teaches individual element of Applicant's claimed invention, but the references either alone or in combination, fail to teach or suggest the claimed combination of hydrophobicity and porosity. Since the references fail to teach or suggest at least one of claimed element, Applicants' independent Claim 15 is not obvious over Fuglevand et al. in view of Mussell et al. and is therefore allowable.

Claims 22 and 51 also claim combinations of graded hydrophobicity and graded porosity. As discussed above with regard to Claim 15, one of skill in the art would not be motivated to combine the references with a reasonable expectation of success at arriving at Applicants' claimed invention. Accordingly, the Examiner has not established a *prima facie* case of obviousness and Claims 22 and 51 are therefore allowable. Moreover, as dependent claims from an allowable independent claim, Claims 23-25 are, by definition, also allowable.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,030,718 to Fuglevand et al. in view of WO 97/13287 to Mussell et al. and U.S. Patent 5,641,586 to Wilson. Applicants respectfully traverse this rejection.

Claims 16 and 17 are allowable for at least the reason that they depend from an allowable independent claim. More particularly, as discussed above, Fuglevand et al., either alone or in combination with Mussell et al. fail to teach or suggest the claimed combination of hydrophobicity and porosity. The examiner relied upon Wilson for teaching or suggesting sintered metal cloths. However, Wilson fails to cure the deficiencies of the primary references. As such, at the references, either alone or in combination, fail to teach or suggest at least one

PES-0043

element of Applicants' independent Claim 15. Therefore, independent Claim 15 is not obvious and is therefore allowable. Moreover, as dependent claims from an allowable independent claim, Claims 16 and 17 are, by definition, also allowable.

Claim 57 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,030,718 to Fuglevand et al. in view of U.S. Patent 5,641,586 to Wilson and U.S. Published Patent Application No. 2001/0008722 to Speranza et al. Applicants respectfully traverse this rejection.

As noted above, U.S. Published Patent Application No. 2001/0008722 to Speranza et al. has an effective date after Applicants' priority date. In other words, Speranza et al. is not available as prior art. As such, the Examiner still has failed to establish a *prima facie* case of obviousness, since as correctly noted by the Examiner Fuglevand et al. and Wilson each fail to teach the claimed materials for the support. Accordingly, Applicants respectfully request that this rejection be withdrawn.

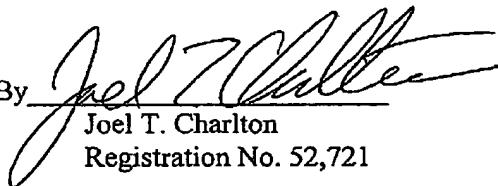
PES-0043

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By 
Joel T. Charlton
Registration No. 52,721

Date: June 6, 2005
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (404) 607-9991
Facsimile (404) 607-9981
Customer No.: 23462